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REMARKS

Applicant thanks Examiner Henderson for his consideration of the application. In response to the Office Action mailed 28 May 2002, the application has been carefully reviewed, and enter of the present amendment is requested.

Rejections Under 35 U.S.C. §102

Claim 35

Claim 35 stands rejected under 35 U.S.C. §102 as being anticipated by Michlin (U.S. Patent 5,141,252 (the '252 patent)).

Examiner Henderson relies upon the '252 patent to disclose "a base sheet (16) with a thickness and a binding edge (folded area located at binding staple 12), a pocket sheet (17) having the same thickness as that of the base sheet (Col. 2, lines 40-46), an adhesive facing the binding edge, and wherein the pocket insert has a maximum thickness equal to a combined thickness of the single thickness (from the base sheet, the single sheet thickness (pocket sheet) and the adhesive." [Paper 13, page 4]

"To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291(Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010(Fed. Cir. 1991)." *Brown v. 3M*, 60 USPQ2d 1375 (Fed. Cir. 2001)

Claim 35 recites:

35. An improved pocket insert for operably passing through a printer or a copier in sequence with a single sheet of paper having a given width and a given length, the improvement comprising:

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(a) a base sheet having a single thickness and a binding edge *located at an end of the sheet, the base sheet having a width equal to the given width and a length equal to the given length;*

(b) a pocket sheet having a single sheet thickness;

(c) an adhesive between the base sheet and the pocket sheet to bond the base sheet to the pocket sheet to form a pocket with an opening facing the binding edge,

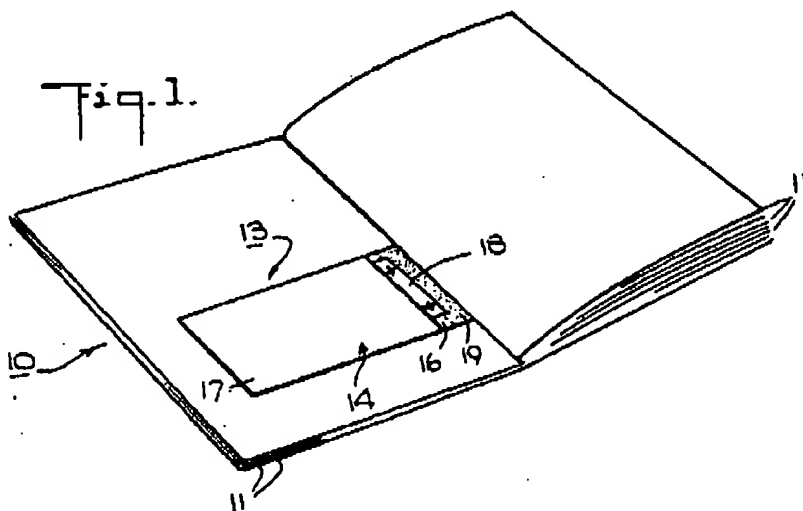
the pocket insert having a maximum thickness equal to a combined thickness of the single thickness, the single sheet thickness and the adhesive.
[emphasis added]

Change 103 /
The asserted base sheet (16) of Michlin does not have a width equal to the given width and a length equal to the [single sheet of paper]. As seen in Figure 1 of Michlin, the sheet 16 does not have a width and length equal to the sheet 11.

U.S. Patent

Aug. 25, 1992

5,141,252



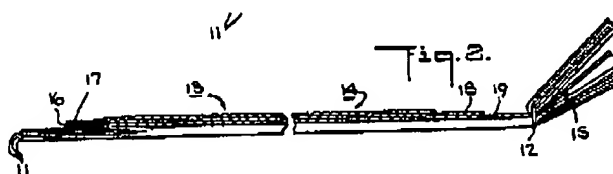
The absence of this limitation precludes Michlin from sustaining the asserted rejection. Thus, Claim 35 is believed in condition for allowance and such action is earnestly solicited.

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Applicant previously submitted there is no binding edge "between 19 and 15."

In response, the examiner has asserted that "a binding edge does not necessarily mean that the edge has to be located at the end of a sheet." [Paper 13, page, 7]



Claim 35 has been amended to recite in part "a binding edge located at an end of the sheet." As such structure is also not disclosed or suggested by Michlin, applicant respectfully submits that Claim 35 is in condition for allowance.

Rejections Under 35 U.S.C. §103

Claims 1-25 and 32-34

Claims 1-25 and 32-34, as best understood, stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dick (U.S. Patent no. 1,495,953) in view of Friedman (U.S. Patent No. 5,042,841) [Paper 13, Page 4]¹

The examiner asserts "Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dick's pocket insert to include a pocket sheet rearranged in which the pocket faces the binding edge as taught by Friedman for the purpose of providing a more secured pocket to hold items from slipping out." [Paper 13, page 5]

This proposed modification is directly contrary to the express purpose of Dick. Dick is directed to having the pocket opening not face the binding edge.

¹ Applicant notes the rejection of these claims under 35 U.S.C. 103 in view of the same references in Paper 11 was Friedman (U.S. Patent No. 5,042,841) in view of Dick (U.S. Patent no. 1,495,953).

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It should be observed that the arrangement of the pockets at the lower portion of the sheet is such that the letters are inserted in a vertical position, thereby enabling the observer to read the titles without it being necessary to turn the book around into different positions. 95

(Col. 2)

Rearranging the pocket as asserted by the examiner would be directly contrary to the express purpose of the primary reference.

Further, Dick states:

This improvement relates to improvements 10 in loose leaf sheets for use in loose leaf binders, and having pockets on the opposite sides or faces thereof, whereby as the sheet is turned in the binder from one side to the other, the pockets are rendered accessible 15 for readily placing articles therein and removing them therefrom.

(Col. 1)

That is, Dick is directed to making it easier to remove and insert media into the pocket. Yet the examiner asserts it would be obvious to modify the reference to make a "more secured pocket to hold items from slipping out." [Paper 13, page 5] This cannot sustain a rejection under 35 U.S.C. §103.

"We have noted elsewhere, as a "useful general rule," that references that teach away cannot serve to create a prima facie case of obviousness. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1131, 1132 (Fed. Cir. 1994)." *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001 (Fed. Cir. 2001)


In response to the prior amendment, Examiner Henderson has taken the position that "adhered" includes "grasping" which in turn includes "stitching".

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In an effort to clarify the relevant terms, Claims 1-25 have been amended to recite in part, "one of chemically bonded, fused or glued" A bond is a chemical bond,² fused means "to liquefy by heat; to render fluid; to dissolve; to melt; 2. to unite or blend, as if melted together,"³ and glued means "to stick or fasten with or as if with glue."⁴

Therefore, Applicant believes all the pending claims, Claims 1-25 and 32-36 are in condition for allowance, and such action is earnestly solicited. If, however, Examiner Henderson feels that any further issues remain, he is cordially invited to call the undersigned so that such matters can be promptly resolved.

Respectfully submitted,


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² The American Heritage® Dictionary of the English Language, Fourth Edition, Copyright © 2000 by Houghton Mifflin Company.

³ Source: Webster's Revised Unabridged Dictionary, © 1996, 1998 MICRA, Inc.

⁴ Source: Webster's Revised Unabridged Dictionary, © 1996, 1998 MICRA, Inc.

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Version With Markings Showing Changes Made

In the Claims

1. (Fourthly Amended) A book comprising multiple pages and a pocket insert bound along a binding, wherein the pocket insert comprises:

(a) a base sheet of paper material comprising a binding edge bound to the binding, the base sheet having a planar first surface and a planar second surface; and

Deck (b) a pocket sheet of paper material, the pocket sheet having a planar inner surface, a planar outer surface, and a perimeter defined by an attached edge section on the inner surface and a free edge section on the inner surface, at least a portion of the attached edge section being one of chemically bonded, fused or glued [adhered] to the first surface of the base sheet along a plurality of seams and the free edge section being unattached to the base sheet to form a pocket opening along the free edge section between the first surface and the inner surface of the pocket sheet,

wherein the base sheet and the pocket sheet are arranged such that the pocket opening faces the binding.

2. The book of claim 1, wherein the pocket opening extends substantially parallel to the binding edge of the base sheet.

3. The book of claim 1, wherein the pocket sheet has a width smaller than a width of the base sheet but at least half the width of the base sheet.

X 4. The book of claim 3, wherein the pocket sheet has a width at least 60 percent of the width of the base sheet.

Deck 5. The book of claim 1, wherein the base sheet and the pocket sheet are formed of separate sheets of paper material that are adhered to one another along the attached edge section of the pocket sheet.

6. The book of claim 1, wherein the base sheet comprises:

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a first edge,

a second edge opposed to the first edge and defining the binding edge, the first and second edges defining a width of the base sheet, and

third and fourth edges opposed to one another and disposed between the first and second edges, the third and fourth edges defining a length of the base sheet.

7. The book of claim 6, wherein the pocket sheet comprises:

a first edge attached to the base sheet,

a second edge opposed to the first edge, the first and second edges defining a width of the pocket sheet, at least a portion of the second edge being unattached to the base sheet for forming the pocket opening, and

third and fourth edges opposed to one another and disposed between the first and second edges, the third and fourth edges defining a length of the pocket sheet and being attached to the base sheet; wherein the pocket sheet has a shorter width than the base sheet.

* 8. The book of claim 7, wherein the base sheet and the pocket sheet are adhered to one another along their respective first edges, third edges and fourth edges.

9. The book of claim 7, wherein the first edges of the base sheet and the pocket sheet are parallel to the second edges of the respective sheets, and the third edges of the base sheet and the pocket sheet are parallel to the fourth edges of the respective sheets.

Cheng 10. The book of claim 9, wherein the base sheet and the pocket sheet are further adhered to one another along a strip parallel to the third and fourth edges of the sheets, so as to separate two pockets formed between the sheets.

11. The book of claim 7, wherein the base sheet and the pocket sheet are formed of a single section of paper material.

12. The book of claim 11, wherein the single section is folded along a fold line defining the first edges of the base sheet and the pocket sheet.

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13. The book of claim 7, wherein the pocket sheet first edge is attached to the base sheet with an adhesive proximate to the base sheet first edge, the pocket sheet third edge is attached to the base sheet with an adhesive proximate to the base sheet third edge, and the pocket sheet fourth edge is attached to the base sheet with an adhesive proximate to the base sheet fourth edge.

change 14. The book of claim 13, wherein the pocket sheet is attached to the base sheet with an adhesive along a strip extending widthwise between the third and fourth edges of the sheets.

change 15. The book of claim 14, wherein the widthwise strip separates two pockets formed by the base sheet and the pocket sheet, both pockets opening towards the base sheet first edge.

16. The book of claim 1, wherein the base sheet is formed of a rectangular sheet of paper having a length of about 11 inches and a width of 8 to 8.5 inches.

17. The book of claim 16, wherein the pocket sheet is formed of a rectangular sheet of paper having a length of about 11 inches and a width of 5 to 6 inches.

18. The book of claim 17, wherein the multiple pages are rectangular sheets having a length of about 11 inches and a width of about 8.5 inches.

19. The book of claim 1, further comprising a front cover and a back cover bound along the binding, the pages and pocket insert being disposed between the front and back covers.

20. The book of claim 19, further comprising supplemental media retained in the pocket.

21. The book of claim 15, further comprising supplemental media retained in both pockets.

22. (Thrice Amended) A pocket insert defined by a base sheet of paper material and a pocket sheet of paper material, the base sheet comprising:

a first edge, a second edge opposed to the first edge for binding to a binder, the first and second edges defining a width of the base sheet, and third and fourth edges opposed to one

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another and disposed between the first and second edges, the third and fourth edges defining a length of the base sheet, the base sheet having a planar first surface and a planar second surface; the pocket sheet having a planar inner surface and a planar outer surface, the pocket sheet comprising:

a first edge of the inner surface [attached] being one of chemically bonded, fused or glued to the first surface of the base sheet, a second edge of the inner surface opposed to the first edge, the first and second edges defining a width of the pocket sheet, at least a portion of the second edge being unattached to the first surface of the base sheet for forming a pocket opening partially defined by the first surface, and third and fourth edges opposed to one another and disposed between the first and second edges, the third and fourth edges defining a length of the pocket sheet and being attached to the first surface of the base sheet; wherein the second sheet has a shorter width than the first sheet and a width at least half the width of the base sheet.

23. The pocket insert of Claim 22, wherein the base sheet and the pocket sheet are formed of separate sheets of paper material that are adhered to one another along their respective first edges, third edges and fourth edges.

Choy 24. The pocket insert of Claim 23, wherein the base sheet and the pocket sheet are further adhered to one another along a strip parallel to the third and fourth edges of the sheets, so as to separate two pockets formed between the sheets.

25. The pocket insert of Claim 22, wherein the base sheet is formed of a rectangular sheet of paper having a length of about 11 inches and a width of about 8 to 8.5 inches, and the pocket sheet is formed of a rectangular sheet of paper having a length of about 11 inches and a width of about 5 to 6 inches.

32. A pocket insert configured to be bound along a binding, the pocket insert comprising:

(a) a base sheet having a planar first surface, a planar second surface and a binding edge selected to be bound to the binding; and

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(b) a pocket sheet having a planar inner surface, a planar outer surface, a perimeter defined by an attached edge section on the inner surface and a free edge section on the inner surface, the attached edge section being attached to the first surface of the base sheet and the free edge section being unattached to the base sheet to form a pocket with a pocket opening along the free edge section and the first surface of the base sheet,

wherein the base sheet and the pocket sheet are arranged such that the pocket opening faces the binding and the pocket insert has a total thickness less than a combined thickness of the base sheet, the pocket sheet and one of the base sheet and the pocket sheet.

33. The pocket insert of Claim 32, wherein a maximum number of pocket sheet thicknesses and the maximum number of base sheet thicknesses at any location of the pocket insert is one.

34. A pocket insert for binding along a bound edge, comprising:

(a) a base sheet having a planar first surface and a planar second surface, and a binding edge selected to be bound at the bound edge;

(b) a pocket sheet having a planar inner surface and a planar outer surface, a portion of the inner surface of the pocket sheet connected to the first surface of the base sheet to form a pocket having a pocket opening between the first surface of the base sheet and the inner surface of the pocket sheet, the pocket opening facing the binding edge.

35. (Twice Amended) An improved pocket insert for operably passing through a printer or a copier in sequence with a single sheet of paper having a given width and a given length, the improvement comprising:

(a) a base sheet having a single thickness and a binding edge located at an end of the sheet, the base sheet having a width equal to the given width and a length equal to the given length;

(b) a pocket sheet having a single sheet thickness;

(c) an adhesive between the base sheet and the pocket sheet to bond the base sheet to the pocket sheet to form a pocket with an opening facing the binding edge,

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the pocket insert having a maximum thickness equal to a combined thickness of the single thickness, the single sheet thickness and the adhesive.

36. A pocket insert for binding along a bound edge, comprising:

(a) a base sheet having a planar first surface and a planar second surface, and a binding edge selected to be bound at the bound edge;

(b) a pocket sheet having a planar inner surface and a planar outer surface, a portion of the inner surface of the pocket sheet connected to the first surface of the base sheet to form (i) a first pocket having a first pocket opening between the first surface of the base sheet and the inner surface of the pocket sheet, the first pocket opening facing the binding edge, and (ii) a second pocket having a second pocket opening between the first surface of the base sheet and the inner surface of the pocket sheet, the second pocket opening facing the binding edge.